

Applic. No. 09/758,299

Amdt. dated September 30, 2003

Reply to Office action of July 2, 2003

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1, 5, 7-11, and 22-24 remain in the application.

Claims 1 and 10 have been amended. Claim 25 has been cancelled.

In item 2 on page 2 of the Office action, claims 1, 5, 7-11, and 22-25 have been rejected as being obvious over Spengler (U.S. Patent No. 4,014,234) in view of Shore et al. (U.S. Patent No. 5,526,726) (hereinafter "Shore") and in view of Barwise et al. (U.S. Patent No. 4,053,004) (hereinafter "Barwise") under 35 U.S.C. § 103.

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. The claims are patentable for the reasons set forth below. Support for the changes is found on page 9, line 24 to page 10, line 10 of the specification.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 10 call for, *inter alia*:

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a sensor disposed in the travel path of the ribbon and monitoring the cutting operation of the ribbon, the sensor connected to the control unit, and the sensor providing control signals to the control unit for controlling operation of the cylinders.

The Spengler reference discloses a cutting apparatus that does not include a sensor.

The Shore reference discloses a high speed shear for end trimming rods.

Contrary to the Examiner's comments on page 3 of the Office action, the Shore reference does not disclose any sensors. Column 1, lines 15-26 of Shore refers to the prior art, which is directed to intermittently operable shears, which necessarily require complex control systems which precisely position the shear blades during each cut in response to rod end position signals generated by sensors located along the rolling line. Therefore, the sensors disclosed in Shore only pertain to the prior art. This is supported by the fact that Shore discloses that a related objective of his invention is the provision of a continually operating shear which inherently makes a single cut in response to diversion of the

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product from its normal path of travel, and which does not require a rod end position signal to coordinate actuation of tile shear blades (column 2, lines 44-49). Therefore, Shore specifically teaches that his invention does not need sensors.

The Barwise reference does not disclose any sensors.

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

The references do not show or suggest a sensor disposed in the travel path of the ribbon and monitoring the cutting operation of the ribbon, the sensor connected to the control unit, and the sensor providing control signals to the control unit for controlling operation of the cylinders, as recited in claim 1 of the instant application.

The references applied by the Examiner do not teach or suggest all the claim limitations. Therefore, the Examiner has not produced a *prima facie* case of obviousness.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant

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application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references themselves must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

Since claims 1 and 10 are believed to be allowable, dependent claims 5, 7-9, 11, and 22-24 are believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1 or 10. Claims 1 and 10 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claims 1 or 10, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1, 5, 7-11, and 22-24 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone

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call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner & Greenberg P.A., No. 12-1099.

Respectfully submitted,

  
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For Applicant(s)

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September 30, 2003

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